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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/830,016

04/23/2004

In Ju Lee

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7659

21171

7590

08/08/2006

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EXAMINER

TRIEU, THERESA

ART UNIT

PAPER NUMBER

3748

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/830,016

Applicant(s)

LEE ET AL.

Examiner

Theresa Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 20 and 22-25 is/are rejected.
- 7) ☒ Claim(s) 17-19 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is responsive to the applicants' amendment filed on May 22, 2006.

Claims 15, 22-24 and 25 have been amended. Accordingly, claims 1-25 are pending in this application..

Applicants' cooperation in correcting the informalities in the specification are appreciated. The objections to the specification as failing to provide proper antecedent basis for the claimed subject matter have been overcome. However, a few minor informalities contain in claims 22 and 25.

Terminal Disclaimer

1. The terminal disclaimer filed on May 22, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application Number 10/829,421 has been reviewed and is NOT accepted.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 15, 16, 20 and 22-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of copending Application No. 10/829,421. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 11 of the copending application "anticipates" application claims 15, 16, 20 and 22-25. Accordingly, application claims 15, 16, 20 and 22-25 are not patentably distinct from copending application claims 1 and 11. Here, copending application claims 1 and 11 require elements a rotating shaft, first and second eccentric cams, first and second eccentric bushes, a slot provided at a predetermined position between the upper and lower eccentric bushes, a locking pin and upper and lower brake units while application claims 15, 16, 20 and 22-25 only require a rotating shaft, first and second eccentric cams, first and second eccentric bush, a locking pin and upper and lower brakes units. Thus it is apparent that the more specific copending claims 1 and 11 encompass application claims 15, 16, 20 and 22-25. Note that since Application claims 15, 16, 20 and 22-25 are anticipated by copending application claims 1 and 11 and since anticipation is the epitome of obviousness, then application claims 15, 16, 20 and 22-25 are obvious over copending application claims 1 and 11. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “configuration unit” recited in claim 22; “a compensation unit” recited in claim 25.

Claim Objections

5. Claims 22 and 25 are objected to, in that their subject matter needs to be incorporated into the specification and the drawings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho et al. (Patent Number 6,860,724) in view of Suzuki et al. (Suzuki) (Patent Number 4,780,067).

Regarding claim 25, as shown in Fig. 1, Cho discloses a variable capacity rotary compressor including upper and lower compression chambers (308a, 308b) having different interior capacities thereof, comprising: a rotating shaft (301) passing through the upper and lower compression chambers and rotatably moving therein; upper and lower eccentric bushes (306a, 306b) communicating with the rotating shaft. However, Cho fails to disclose a compensate unit.

As shown in Fig. 1, Suzuki teaches that it is conventional in the art to utilize a compensation unit (22). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the compensate unit, as taught by Suzuki in the Cho apparatus, since the use thereof would have control the rotating of the upper and lower eccentric bushes from rotating faster than the rotating shaft. Note that in claim 25, the limitation “to prevent the upper and lower eccentric bushes.... shaft rotates” is a function implication. All functional implication and the statement of intended use have been fully considered. However, they are deemed not to impose any structural limitations distinguishable over the Suzuki device, which is certainly capable of performing as a compensation unit if so desired. In other words, the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Allowable Subject Matter

7. Claims 1-14 are allowed.

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8. Claims 17-19 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicants' arguments filed on May 22, 2006 have been fully considered but they are not persuasive.

Applicants argue that the double patenting rejection is overcome by the attached terminal disclaimer (see Remarks section, page 11). However, the terminal disclaimer has not been approved as set forth above.

Applicants argue that there is no suggestion or motivation to modify the reference or to combine the references of Cho '724 with Suzuki '067 (see Remarks section, page 11). Both references Cho '724 and Suzuki '067 references; however, have the same basic a multicylinder rotary compressor having a plurality compression chambers to vary a compression capacity according to a direction of rotation of roller. Since the rotary compressor of these references are of the same basic structure and operate in substantially the same manner there would be a suggestion to combine the disclosures.

In response to applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). The examiner recognizes that references cannot be arbitrarily combined and that there must be some reasons why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In this case, Cho teaches that the rotary compressor having a shaft passing through the upper and lower compression chambers and the upper and lower bushes communicating with the shaft. Suzuki herein merely for the teaching that it is conventional to utilize a compensate unit for controlling the rotating of the upper and lower eccentric bushes from rotating faster than the rotating shaft. The examiner maintains that one of ordinary skill would have found it obvious to utilize the compensate unit as taught by Suzuki to control the rotating of the upper and lower eccentric bushes with respect to the shaft. The claims do not patentably define over the combination of references as set forth in the above rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT
July 25, 2006



Theresa Trieu
Primary Examiner
Art Unit 3748